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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,859	09/06/2001	Bronwyn Jean Battersby	21415-0005	4713

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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT PAPER NUMBER

1639

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/856,859

Applicant(s)

Battersby et al

Examiner  
Maurie G. Baker, Ph.D.

Art Unit  
1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-62 are subject to restriction and/or election requirements

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1639 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

### *Election/Restriction*

1. Restriction is required under 35 U.S.C. 121 and 372. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
2. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention from the following groups to which the claims must be restricted.
  - I. Claims 1-14, drawn to a carrier.
  - II. Claims 15-29, drawn to a plurality of carriers.
  - III. Claims 30-38, drawn to a method of producing a plurality of carriers.
  - IV. Claims 39-46, drawn to a method of synthesizing and deconvoluting a combinatorial library.
  - V. Claim 47, drawn to a combinatorial compound library.
  - VI. Claims 48-62, drawn to a kit.

3. The inventions listed as Groups I – VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the reasons that follow.

4. The technical feature that links all of the claims is the “carrier” described by claim

1. The groups lack unity because the claimed carriers are known in the art as disclosed by Nova et al (US 5,751,629). This reference is described below.

5. Nova et al disclose “[c]ombinations, called matrices with memories, of matrix materials with remotely addressable or remotely programmable recording devices” for use in combinatorial chemistry (see Abstract). The “matrix” of Nova et al reads on the instant “carrier”, see, for example, Nova et al column 10, line 49 through column 11, line 20. The “memory” of Nova et al reads on the instant “attributes” that are “detectable and/or quantifiable”, see, for example, column 11, line 33 through column 12, line 40 of the reference. Nova specifically discloses electromagnetic tags in proximity to the matrix (column 12, lines 23-40 and 55-59). The “combinations” of Nova comprise the matrix in physical contact with the memory in a covalent or non-covalent fashion (see column 5, line 53 through column 6, line 29).

Also, the “matrices with memories” are additionally covalently or non-covalently bound to a molecule or biological particle (column 6, lines 31-40). The information in the memory of Nova identifies or tracks the biological particle or molecule (column 12,

lines 60-67). Specific use of the “matrices with memories” in combinatorial chemistry is disclosed, for example, in column 7, line 47-67 and Figures 1-4.

6. Also, the products of Groups I, II, V and VI all are different in their form and their modes of use and reactivity would be different. Further, they represent separate and distinct products (different inventive concepts). They differ in respect to their properties, the synthetic methodology for making them and/or their use. The inventions of Groups III and IV also represent different inventive concepts as they represent different methods, with different steps, different reagents and/or different end results.

7. Moreover, see MPEP 1850: Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By “dependent” claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression “category of claim” referring to the classification of claims according to the subject matter of the invention claimed, for example, product, process, use or apparatus or means, etc.).

8. See 37 CFR § 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage, cited in part below (especially sections (c) and (d)).

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”). Where a group of inventions is claimed in an application, the requirement of unity of

invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

The instant international application contains multiple products and methods, where the feature that links the claims is known in the art, as set forth above. Thus, the instant claims lack unity of invention.

9. This application contains claims directed to more than one species of the generic invention for Groups I – VI. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 (see paragraphs 16-18 below). The species are set forth as follows for each group with the claims corresponding to the species and the generic claims also set forth.

10. If applicant elects the invention of **Group I**, applicant is required to elect from the following patentably distinct species. Claim 1 is generic.

Species of carrier

Applicant is required to **specifically** elect a carrier. All portions thereof should be defined, including:

- Number and specific type of attributes
- Location of attributes (e.g. claim 2)
- Shape and form of carrier (e.g. claim 13)
- Specific type of carrier (i.e. polymeric or ceramic), defining form (e.g. claim 9), diameter (e.g. claim 12) and functionalities thereon (e.g. claim 14)

11. If applicant elects the invention of **Group II**, applicant is required to elect from the following patentably species. Claim 15 is generic.

Species of plurality of carriers

Applicant is required to **specifically** elect a plurality of carriers. All portions of **each** of the carriers in the plurality should be defined, including:

- Number and specific type of attributes on *each* carrier
- Location of attributes on *each* carrier (e.g. claim 16)
- Shape and form of *each* carrier (e.g. claims 23 and 24)
- Specific type of *each* of the carriers (i.e. polymeric or ceramic), defining form, size & diameter (e.g. claims 15 & 28) and functionalities (e.g. claim 29)

12. If applicant elects the invention of **Group III**, applicant is required to elect from the following patentably distinct species. Claim 30 is generic.

Species of carrier made

Applicant is required to **specifically** elect a carrier made by the claimed method. All portions thereof should be defined, including:

- Number and specific type of attributes
- Location of attributes
- Shape and form of carrier
- Specific type of carrier (i.e. polymeric or ceramic)

13. If applicant elects the invention of **Group IV**, applicant is required to elect from the following patentably distinct species. Claim 39 is generic.

Species of carrier used

Applicant is required to *specifically* elect a carrier used in the claimed method. All portions thereof should be defined, including:

- Number and specific type of attributes
- Location of attributes
- Shape and form of carrier
- Specific type of carrier (i.e. polymeric or ceramic)

14. If applicant elects the invention of **Group V**, applicant is required to elect from the following patentably distinct species. Claim 47 is generic.

Species of library

Applicant is required to *specifically* elect a combinatorial chemical library.

15. If applicant elects the invention of **Group VI**, applicant is required to elect from the following patentably species. Claim 48 is generic.

Species of plurality of carriers in the kit

Applicant is required to *specifically* elect a plurality of carriers that is present in the instant kit. All portions of *each* of the carriers in the plurality should be defined, including:

- Number and specific type of attributes on *each* carrier
- Location of attributes on *each* carrier (e.g. claim 49)
- Shape and form of *each* carrier (e.g. claims 56 and 57)
- Specific type of *each* of the carriers (i.e. polymeric or ceramic), defining form, size & diameter (e.g. claims 58 & 61) and functionalities (e.g. claim 62)

16. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons.



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17. PCT Rule 13.2 states that unity of invention shall be fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features". It further defines "special technical feature" as "those technical features that define a contribution which each of the claimed inventions, claimed as a whole, makes over the prior art". For example, unity of invention is fulfilled if:

- (a) all alternatives have a common property; **and**
- (b) (i) a common structure is present, i. e. a significant structural element is shared by all alternatives, or
- (b) (ii) in cases where the common structure can not be the unifying criterion, all alternatives belong to a recognized class of compounds in the art to which the invention pertains. (MPEP 1850).

18. In the instant case, part (a) above is not fulfilled because all claimed species do not have a common property (i.e. have different attributes). Further, all of the species do not belong to a recognized class of materials in the art to which they pertain (i.e. have different structures and modes of action). Moreover, the claimed carriers are known in the art, see paragraphs 4 and 5 above.

For these reasons, election under these rules is proper and required.

19. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

20. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

21. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

22. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

23. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR

1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.  
November 12, 2002

A handwritten signature in black ink, appearing to be 'MB' followed by a long horizontal stroke.

MAURIE GARCIA BAKER, Ph.D.  
PATENT EXAMINER



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

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TO EXAMINER: Maurie Garcia Baker, Ph.D.

ART UNIT: 1639

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